

### **REMARKS /ARGUMENT**

The following is a reply to the final Office Action mailed on March 19, 2008. Applicant respectfully submits that in view of the amendment to the claims and the following remarks and arguments, the rejections set forth in the Office Action are deemed to be overcome, thus placing the instant application in condition of allowance.

Applicant is the Assignee of the present application and is prosecuting the present application under 37 C.F.R. § 3.71. A statement under 37 C.F.R. § 3.73(b) is submitted herewith.

#### **I. Interview with the Examiner**

Applicant thanks the Examiner for the interview conducted with the undersigned on March 19, 2009. The issues discussed in the interview are substantially set forth in sections III and IV below. The remarks below thus serve as a Summary of Interview. Applicant wishes to express appreciation that an understanding has been reached with the Examiner with respect to these issues.

#### **II. Status of claims**

Claims 49, 50, 62 – 232 were previously pending in these applications. With the present amendment claims 97 – 111, 149 – 163 and 201 – 215 are being cancelled without prejudice. Applicant reserves the right to prosecute the cancelled claims in continuation or other related applications. It is further respectfully noted that the cancellation of these claims is not to be construed as intending in any way to affect the scope and breadth of the claims that currently remain pending. The remaining pending claims are expressly intended to be afforded the full scope and breadth as afforded to them previously.

Additionally, the present amendment adds new claims 233 – 270. The new claims are “system” claims counterparts to the “method” claims of 166 - 200, 216, 217, and 230.

Thus currently pending in the present application are claims 49, 50, 62 – 96, 112 – 148, 164 – 200, and 216 – 270. The pending claims are to be construed in light of the remarks submitted in previous amendments and submissions under sections entitled “claim

construction”.

### **III. Inventorship**

In the Office Action, the Examiner notes the following:

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time of the later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 USC 102(e), (f) or (g) prior art under 35 U.S.C. 103(a). Based upon the Applicant's remarks dated December 4, 2007, Mr. Salisbury can be deemed a joint inventor at least to claims 34 (cancelled), 46 (cancelled), 59 (cancelled), and 231 (pending) and 232 (pending). The examiner notes that the phrase “at least to” does not satisfy the obligation set forth by 37 CFR 1.56.

Office Action p. 2.

In response, Applicant respectfully notes that Applicant's remarks from December 4, 2007 regarding Mr. Salisbury's inventorship were not intended to suggest that the invention dates of the pending claims were not commonly owned at the time of their respective invention.

Applicant's remarks simply intend to inform the Examiner that Applicant has reevaluated Mr. Salisbury's contribution to the pending claims and whether Mr. Salisbury is a properly named inventor. Upon reevaluation, Applicant confirmed that Mr. Salisbury is indeed a properly named inventor having contributed to at least claims 231 and 232. Thus Applicant's remarks were simply intended to inform the Examiner that a concern was raised about Mr. Salisbury inventorship contribution and that the concern was obviated.

In any event, to the best of Applicant's knowledge, Mr. Salisbury only contributed to claims 231 and 232.

### **IV. Priority**

In the Office Action, the Examiner notes the following:

...In the Applicant's remarks, it is admitted that it has recently come to their attention that the joint inventors are not common owners of the entire invention. Therefore, it is impossible for the examiner to make a determination regarding

the priority dates and which inventor is to be assigned to each claim in the instant application and in the prior application 08/787,979...

Office Action p. 3.

In response it is noted that in light of Applicant's remarks *supra* regarding inventorship, the Examiner's concerns regarding the claim for priority are deemed to be obviated. As noted, all of the claimed inventions of the present application and the prior application 08/787,979 ("979 Application") were commonly owned. Applicant's remarks were simply intended as *confirmatory*, i.e., that indeed each of the named inventors contributed to at least one pending claim.

Applicant's priority claim to the filing date the '979 Application is therefore proper.

The Examiner is respectfully requested to acknowledge the claim of priority to the '979 Application.

#### **V. Claim Rejections**

##### **A. Rejection under 35 U.S.C. § 102(b) over Yager**

The Examiner rejected claims 49, 50, 62-55, 114-118, 166-170 and 218 under 35 U.S.C. § 102(b) as being anticipated by Yager.

In response it is noted that each of the pending claims is supported by the specification of the '979 Application, and is afforded the priority filing date of the '979 Application, i.e., January 22, 1997. The Yager reference appears to be from December 1997 and is hence not prior art to the pending claims.

##### **B. Rejection under 35 U.S.C. § 103(a) over Yager**

The Examiner rejected claims 67-113, 119-165, and 171-217 as being unpatentable under 35 U.S.C. § 103(a) in view of Yager.

As noted above, each of the pending claims is to be afforded the priority filing date of the '979 Application. Thus Yager cannot be considered prior art to the pending claims.

**C. Rejection under 35 U.S.C. § 103(a) over Citation I**

The Examiner also rejected claims 49, 50, 62-232 under 35 U.S.C. § 103(a), in view of the remarks found in Citation I (Roth preliminary Motion No. 2), submitted in the IDS dated March 5, 2007 ("Citation I").

Applicant respectfully traverses the rejections in light of the following remarks.

Citation I is a preliminary motion that was submitted to the Board of Patent Appeals and Interferences in the course of an interference proceeding that involved the '979 Application. Citation I points to a number of references, including *Dedrick*, *Logan*, *Reilly*, *Fujisaki*, *Murphy* and *Toland*.

The references cited in Citation I, either standing alone or in combination with each other, do not render the pending claims unpatentable.

The subject matter of the pending claims provide for real-time bidding and selecting of advertisements in response to a request for content from a browser. The real time bidding mechanism is a truly novel approach to advertising, whereby advertisers can compete against each other in real time during the time which the opportunities to serve advertisements to web browsers arise. Additionally, the bidding mechanisms are applied to each advertising opportunity individually.

Nothing in the references mentioned teach or suggest a real time bidding mechanism for internet advertising. Further, nothing in the references teach or suggest competitive bidding for individual advertising opportunities. Thus, each of these features for itself constitutes a significant improvement and contribution over the mentioned references.

Lastly, it is noted beyond need, that the preliminary motion shown in Citation I was subsequently withdrawn during the interference. See Citation U ("Roth's motion to dismiss motions nos. 1-4"), submitted with the IDS of March 5, 2008. Thus, to the extent any remarks by Applicant in the preliminary motion is deemed prejudicial, such remarks were timely withdrawn during the interference.

**VI. Related Applications**

The present application is related to Application Nos. 10/655,549, 09/372,416, 11/675,429. The subject matter claims in each of the foregoing application is of similar scope to the pending claims of the present application. Rejections were issued and remain outstanding in each of the foregoing related applications and are thus believed to be relevant to the present application. Applicant trusts that the Examiner will review, to the extent deemed necessary, the contents of the file wrappers for the foregoing applications to determine the applicability of their contents, including the rejections, to the pending claims. The present application is also related to a number of continuation applications for which the examination process has yet to begin.

**CONCLUSION**

In view of the foregoing remarks, the present application is believed to be in condition of allowance. For any outstanding issues concerning the present application the Examiner is respectfully requested to contact the undersigned at the number listed below.

Dated: March 19, 2009

Respectfully submitted,  
BEH Investments LLC

Signature: Benzion WachsmanName: Benzion A. WachsmanTitle: General Manager

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**CERTIFICATE OF MAILING**

I, the undersigned, hereby certify that the following correspondences are being deposited with the United States Postal Service on this day of March 19, 2009, with sufficient postage as priority mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature Benzion Wachsman Name: Benzion A. Wachsman